

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of	:	Conf. No.: 2776
	:	
Eric J. Streciwilk	:	Group Art Unit: 3723
	:	
Serial No.: 10/806,499	:	Examiner: Grant, Alvin J.
	:	
Filed: March 23, 2004	:	
	:	
For: AGITATOR CAVITY FITTING FOR	:	
FLOOR CARE CLEANING APPARATUS	:	

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief follows the Examiner's Answer mailed May 26, 2010. This reply is necessary to address the Examiner's remarks in response to Appellant's Appeal Brief filed February 9, 2010.

With regard to the Examiner's rejection of claims 3, 4, 10, 11, 16, and 19-21 under 35 U.S.C. § 103(a) as being obvious in view of U.S. Reissued Patent No. RE 31,095 to Tschudy (the "'095 Patent") combined with U.S. Patent No. 6,226,832 to McCormick (the "'832 Patent"), the Examiner repeats the arguments from the final Office Action dated January 5, 2010, to which Appellant's Appeal Brief was fully responsive.

Nevertheless, Appellant believes it is necessary to address several statements and omissions in the Examiner's Answer.

At the outset, Appellant argued that the Examiner's proposed modification changes the principle of operation of the invention disclosed in the '095 Patent. *Appeal Brief*, p. 9-14. Nowhere in the Examiner's Answer is this issue addressed. The Examiner fails to provide any argument whatsoever countering Appellant's arguments. For the reasons outlined in the Appeal Brief, and since the Examiner fails to argue otherwise, the proposed modification is improper and no *prima facie* case of obviousness can be established. *See* MPEP 2143.01(VI) ("If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious."); *see also, In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Next, Appellant argued that the Examiner has failed to provide a reason why a skilled artisan would combine the '095 and '832 Patents. *Appeal Brief*, p. 14 and 15. Appellant stated that the Examiner has failed to meet his burden of providing a proper reason for combining the patents, as required by the U.S. Supreme Court. *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398; 127 S. Ct. 1727, 167 L. Ed. 2d 705 (U.S. 2007) (it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements." *Id.* at 1741. A proper "reason" must also have a rational underpinning, which must be articulated in the record. *Id.*)

In the Examiner's Answer, the Examiner again fails to provide a proper reason with a rational underpinning for combining the elements of the cited references. The Examiner fails to even mention this issue. Accordingly, for this additional reason, the Examiner has failed to establish a *prima facie* case of obviousness.

Moreover, the Examiner fails to establish that the '095 and the '832 Patents teach or suggest the limitations of the pending claims. Pages 16-20 of the *Appeal Brief* fully establish this point and the Examiner's Answer fails to refute Appellant's arguments. For example, the Examiner argues in the Examiner's Answer that "Tschudy [the '095 Patent] discloses a channel portion (46) that is connected with the agitator housing that comprises a channel that has grooved sections therein that are considered to be air guides." *Examiner's Answer*, p. 4. Interestingly, on page 3 of the *Examiner's Answer*, the Examiner identifies element 46 of the '095 Patent as "a connector." In other words, the Examiner is using the structure 46 of the '095 Patent as two separate elements of claim 3, which is entirely improper. Appellant's claim 3 requires a housing "including at least one receiver receiving said at least one mounting lug, at least one slot receiving said at least one connector and a channel for receiving said air guide." The suction connection 46 of the '095 Patent is clearly not the connector or channel of claim 3, much less, both of the elements as proposed by the Examiner.

As discussed in the *Appeal Brief*, the Examiner has failed to specifically point to where many elements of the pending claims are allegedly taught or suggested by the '095 and/or the '832 patents. Instead, he resorts to conclusory statements that provide no

specificity. Further examples of inappropriate conclusory statements are also found in the Examiner's Answer. In the "Response to Argument" on page 4 of the Examiner's Answer, the Examiner states "[i]n response to Appellant's arguments that Tschudy does not disclose a mounting 'lug on' in [sic] any aperture on the housing, this feature is taught by US Patent 6,226,832 (to McCormick) as is indicated in the Office Action." (emphasis added). However, *neither the Office Action of October 5, 2009, the Office Action of January 5, 2010, nor the Examiner's Answer identifies where the '832 Patent teaches an agitator cavity fitting including at least one mounting lug, as required by claim 3.* Instead, the Examiner states the following:

Tschudy [the '095 Patent] does not specifically disclose the use of a lug. McCormick [the '832 Patent] discloses a vacuum in which a lug is used to secure the agitator shield to the nozzle so as to facilitate the removal of the inner shield from the nozzle assembly. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used a lug to secure the agitator shield to the nozzle of Tschudy's [the '095 Patent] apparatus so as to facilitate the removal of the inner shield from the nozzle assembly. *Examiner's Answer, p. 4.*

Merely saying that that a reference teaches a limitation without pointing to the exact teachings the Examiner relies on is inappropriate and does not provide a *prima facie* case of obviousness. It is not Appellant's duty to guess what portions of a reference an Examiner is referring to or relying on and how this constitutes the limitation of the pending claim. The mere fact that '832 Patent may generally teach "a lug" does not equate to the "mounting lug" of claim 3, "including at least one receiver receiving said at

least one mounting lug.” Since the Examiner has failed to provide a case of *prima facie* obviousness, the rejections must be withdrawn.

With specific regard to claim 21, Appellant argued that the Examiner has failed to identify where the ‘095 and/or ‘832 Patents teach a tab carried on the housing, a notch carried on the agitator cavity fitting, and the tab engaging the notch. In response the Examiner states the following on page 4 of the Examiner’s Answer:

In response to Appellant’s arguments that Tschudy [the ‘095 Patent] does not disclose a tab on the housing and notch on the agitator, Tschudy discloses a tab and notch configuration that is in the reversed order and it functions equally well.

Again, the Examiner’s statement is without any specific reference to the cited patents. In a “free word” search of the ‘095 Patent, Appellant’s counsel was unable to find any use of the word “tab” or “notch” in the patent. Moreover, as established by the Federal Circuit, “[t]he broadest-construction rubric. . . does not give the PTO an unfettered license to interpret claims to embrace anything remotely related to the claimed invention.” *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260, 94 USPQ2d 1641 (Fed. Cir. 2010). Since the ‘095 Patent makes no mention of a “tab” or “notch” and the Examiner fails to provide specific arguments to the contrary, the rejection to claim 21 must be withdrawn.

After careful review of Appellant’s Appeal Brief and this Reply Brief, it is believed that the Board will agree that all of the presently pending claims should be allowed. Accordingly, it is respectfully requested that the rejections of the Examiner be reversed and the present application be remanded for allowance. Although Appellant

believes that no fees are due, the undersigned authorizes the deduction of any necessary fees from Deposit Account 11-0978.

Respectfully submitted,

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